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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,992	12/14/2001	Bernhard Hanke	08056-1-0020	7145
26135	7590	11/19/2003	EXAMINER	
LOTT & FRIEDLAND, P.A. P.O. BOX 141098 CORAL GABLES, FL 33114-1098				ZIMMER, MARC S
ART UNIT		PAPER NUMBER		
		1712		

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/017,992	Applicant(s) HANKE ET AL.
Examiner	Art Unit	
Marc S. Zimmer	1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 14 July 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-14 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-14 is/are rejected.  
7)  Claim(s) 1-14 is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_.  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6)  Other: \_\_\_\_.

***Claim Objections***

Claims 1-14 are objected to because of the following informalities: Applicant discloses a composition partially in terms of its constitution at an exposed surface. However, insofar as compositions are dimensionless (but products/articles are not), claiming a composition in terms of its makeup at a boundary is untenable. Besides, in view of the manner in which said composition is prepared according to the Specification, it is submitted that the entire composition will contain an even distribution of the metallic silver.

It is, therefore, recommended that Applicant consider rewriting claim 1 to recite a silicone rubber composition comprising a homogeneous mixture of silicone rubber, an organic matrix, and silver nanoparticles. (Whatever wording Applicant decides to employ, the claim should at least mention silicone rubber in the body of the claim because, as the claim presently reads, the organic matrix would be taken as being representative of the silicone rubber as there is no allusion to a siloxane polymer material elsewhere in the body of the claim.) Indeed, it is this shortcoming in the claim that is the basis of the double patenting rejection set forth infra.

It is also submitted that Applicant consider identifying the organic matrix in terms of its role, i.e. as a dispersing aid, in order to further establish that this component is supposed to be an ingredient that is incorporated *in addition to* the silicone rubber as “organic matrix” is non-descript.

In claim 6, Applicant intends to further limit the identity of the organic matrix but refers to the same as an organic fluid. The word “fluid” should be replaced with “matrix”

though, again, it is suggested that Applicant characterize this component in terms of its intended role as a means of distinguishing this ingredient from the host silicone rubber.

Applicant is reminded that any amendment of the language in the claims should be replicated in the Specification to homogenize the terminology.

***Claim Rejections- 35 U.S.C. § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no antecedent basis in claim 1 for "said" viscous organic fluid in claim 6. The word viscous should be removed as there is no previous indication that the organic matrix must have a viscous consistency. Furthermore, the substances disclosed in claim 6 are not embodiments of a silicone rubber thus there is no antecedent basis in claim 1 for these classes of material.

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of copending Application Serial No. 10/017,996. U.S. Patent Application Publication No. 2002/0122832, which is based on Application Serial No. 10/017,996, is provided for Applicant's convenience so that the claims having similar subject matter may be compared. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. It is supposed for the purpose of this rejection that "organic matrix" is representative of the silicone rubber inasmuch as there is no formal mention of a silicone rubber anywhere in the body of the claim. In this instance, instant claim 1 differs from claim 7 of the counterpart application only in that, whereas a specific silver containing-portion of the product is delineated as that "contacting human or animal skin and/or mucosa in the latter, present claim 1 only mentions the presence of silver on a an exposed surface. However, any product that would be placed in contact with a human or animal skin, which, incidentally, is merely a recitation of intended use, would necessarily have its active agent (in this case silver nanoparticles) on the surface hence the silicone product of claim 7 of U.S. Applicant No. 10/017,996 is identical in scope to the composition of claim 1 of the present application.

It is appreciated that the "organic matrix" recited in claim 1 is, in fact, intended to be a component separate of the silicone rubber. Nonetheless, the Examiner believed it

was essential that the alternative, but valid, ways of construing the claims and the implications of these alternate interpretations be made clear to the Applicant because numerous attempts to explain the deficiencies in claim 1 over several telephone interviews were unsuccessful. In addressing the matters raised herein, Applicant should be careful to modify the dependent claims and Specification so that the terminology is uniform throughout.

***Allowable Subject Matter***

Claims 1-14 would be allowable if rewritten or amended to overcome the various rejections and objections set forth in this Office action. As before, the prior art does not disclose, or reasonably suggest a polysiloxane composition containing what amounts to a dispersing aid and silver particles having the specified average particle size.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 703-605-1176. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

November 5, 2003



Robert Dawson  
Supervisory Patent Examiner  
Technology Center 1700